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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/696,465 | 10/25/2000 | Charles C. Birkner | | 4034 |

31688 7590 10/13/2004

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EXAMINER

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ART UNIT PAPER NUMBER

3623

DATE MAILED: 10/13/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/696,465
Filing Date: October 25, 2000
Appellant(s): BIRKNER ET AL.

Charles C. Birkner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/14/04.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims stand or fall together based on the grounds of rejection. Therefore, claims 1-6, 8-12, and 14-20 stand or fall together and claims 7 and 13 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Meridian Project Systems, Inc. (www.mps.com), screenshots archived by archive.org between 12/1999-01/2000.

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(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6, 8-12, and 14-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Meridian Project Systems, Inc. (www.mps.com), archived by archive.org between 12/1999-01/2000.

As per claim 1, Meridian Project Systems, Inc. teaches a construction management system, comprising:

A handheld computer adapted to collect construction data from the field (See at least page 1, section 1-4, and page 28, sections 1 and 3, wherein a handheld computer is disclosed that allows construction data to be collected from the field);

a planning system to track budgetary information that manages multi-year budgets (See at least page 1, sections 1-2, page 2, section 1, page 3, section 3, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3, wherein planning system features are disclosed that track the budget information. See also pages 30 and 31, page 32, section 1, and page 33, section 1, wherein dates for the project can be entered and multi-year projects can be planned and managed using a budget tracking system);

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A design system to perform site engineering assessment (See at least page 1, sections 1-4, page 2, section 1, page 3, sections 1-5, page 13, sections 1 and 3, page 15, and page 28, sections 1-3, which includes a system for engineers and engineering site analysis);

A construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer (See at least page 1, sections 1-2, page 2, section 1, page 3, sections 1-5, page 4, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3, which discloses a construction system to track progress and material consumption to generate reports using information from the handheld computer).

As per claim 2, Meridian Project Systems, Inc. teaches a system wherein the handheld computer collects work in progress data (See at least page 1, sections 1-2, page 2, section 1, page 3, sections 1-5, and page 4, wherein the handheld computer is used to collect work in progress data).

As per claim 3, Meridian Project Systems, Inc. teaches a system wherein the handheld computer collects project and contract identification, inspector identification, item number, location, and one or more description of activities (See page 1, sections 1-4, page 3, sections 1-5, pages 10-12, page 13, page 14, section 1, page 15, sections 5 and 6, and page 16, which includes project and contract identification, item numbers, location, and one or descriptions).

As per claim 4, Meridian Project Systems, Inc. discloses a system wherein the handheld computer collects labor related information (See page 1, section 1-4, page 2, page 3, section 1, pages 11-12, page 13, page 15, section 6, page 16, section 1, and page

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28, sections 1-3, wherein the handheld computer collects information including labor information).

As per claim 5, Meridian Project Systems, Inc. discloses a system wherein the handheld computer collects labor type, quantity, and hours (See page 1, section 1-4, page 2, page 3, section 1, page 12, page 13, page 15, section 6, page 16, section 1, and page 28, sections 1-3, wherein the handheld computer collects labor type, quantity, and hours).

As per claim 6, Meridian Project Systems, Inc. teaches a system wherein the handheld computer collects equipment information (See page 1, sections 1-4, page 3, section 2, page 13, page 15, section 5, and page 28, sections 1-3, which discloses equipment information being collected via the handheld computer).

As per claim 8, Meridian Project Systems, Inc. teaches a system wherein the handheld computer collects submittal information (See at least page 1, sections 1-2, page 2, section 1, page 3, sections 1-5, page 4, page 13, page 15, and page 28, sections 1-3, which disclose the handheld computer collecting submittal information).

As per claim 9, Meridian Project Systems, Inc. teaches a system wherein the handheld computer collects weather condition, comments, and an inspector name (See page 1, section 2, page 3, sections 1-5, pages 10-12, page 13, section 3, page 16, section 2, and page 28, sections 1-3, wherein the handheld computer collects weather condition, comments, and an inspector name).

As per claim 10, Meridian Project Systems, Inc. discloses a system wherein the handheld computer sends collected information to a server (See page 1, sections 1-4, pages 5-6, page 8, section 1, pages 19-20, and page 28, sections 1-3, wherein the handheld computer uploads and downloads information to a server).

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As per claim 11, Meridian Project Systems, Inc. teaches a system wherein the collected information is sent wirelessly transmitted using a handheld wireless unit (See page 1, sections 1-4, pages 5-6, page 8, section 1, pages 19-20, and page 28, sections 1-3, wherein the collected information is wirelessly transmitted. Page 8, section 1, discloses a technical requirement of the handheld unit as ActiveSync 3.0, which allows for wireless data transmissions).

As per claim 12, Meridian Project Systems, Inc. teaches a system further comprising a modem coupled to the handheld computer, wherein the information is transmitted using a modem (See page 1, sections 1-4, pages 5-6, page 8, section 1, pages 19-20, and page 28, sections 1-3, wherein the collected information is wirelessly transmitted. Page 8, section 1, discloses a technical requirement of the handheld unit as ActiveSync 3.0, which allows for transmissions using a modem).

As per claims 14, 15, 16, 17, and 18, claims 14, 15, 16, 17, and 18 are method version of claims 1, 2, 4, 9, and 11, respectively, and are therefore rejected using the same art and rationale as the rejections of claims 1, 2, 4, 9, and 11, respectively.

As per claim 19, Meridian Project Systems, Inc. teaches a method wherein the handheld computer collects project and contract identification, inspector identification, item number, location, one or more description of activities, labor type, quantity, hours, weather condition, comments, and an inspector name (See page 1, sections 1-4, page 3, sections 1-5, pages 10-12, page 13, page 14, section 1, page 15, sections 5 and 6, and page 16, which includes project and contract identification, item numbers, location, and one or descriptions. See page 1, section 2, page 3, sections 1-5, pages 10-12, page 13,

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section 3, page 16, section 2, and page 28, sections 1-3, wherein the handheld computer collects weather condition, comments, and an inspector name).

As per claim 20, Meridian Project Systems, Inc. teaches a method further comprising sending collected information to a server over a land-line or wireless medium (See page 1, sections 1-4, pages 5-6, page 8, section 1, pages 19-20, and page 28, sections 1-3, wherein the collected information is wirelessly transmitted. Page 8, section 1, discloses a technical requirement of the handheld unit as ActiveSync 3.0, which allows for wireless data transmissions).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meridian Project Systems, Inc. (www.mps.com).

As per claim 7, Meridian Project Systems, Inc. discloses a system wherein the handheld computer collects equipment information, including summary information by company (See at least page 1, sections 1-4, page 3, section 2, page 11, and page 15, section 5, wherein the handheld computer collects equipment type).

However, Meridian Project Systems, Inc., does not expressly disclose that this information includes type, quantity, hours in use and stand-by hours.

Meridian Project Systems, Inc. discloses collecting and reporting information about equipment used in a construction project. Type, quantity, hours in use and stand-

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by hours are all known equipment information items in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include type, quantity, hours in use and stand-by hours in the information collected about the equipment of the project in order to increase the accuracy and the detail of the information collected and stored in the system. Page 1, section 2, discusses the importance of accurate and detailed information.

As per claim 13, Meridian Project Systems, Inc. discloses a system further comprising a cradle coupleable to the handheld computer, the cradle gathering the collected information for transmission to a server (See page 1, sections 1-4, pages 5-6, page 8, section 1, pages 19-20, and page 28, sections 1-3, wherein the collected information is wirelessly transmitted. Page 8, section 1, discloses a technical requirement of the handheld unit as ActiveSync 3.0, which allows for coupling for transmission).

However, Meridian Project Systems, Inc. does not expressly disclose a hot-sync cradle.

Meridian Project Systems, Inc. discloses that the handheld computer couples with another computer to download and upload collected data. HotSync is known in the art and is the registered trade name for a method of linking between a handheld computer and a more substantial computer. It would have been obvious to one of ordinary skill in the art at the time of the invention to use HotSync to transmit the information in order to more efficiently transfer information, as discussed on page 1, section 2.

(11) *Response to Argument*

In the Appeal Brief, Appellant provides four main arguments:

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- 1) Meridian Project Systems, Inc. does not teach or suggest a planning system that tracks funding sources, allocates funding sources and scheduling information, maintains data relating to preliminary site feasibility studies, or handles multi-year projects or other aspects of the planning system disclosed in the specification;
- 2) Meridian Project Systems, Inc. does not teach or suggest design functionality or the claimed design system with the functionalities disclosed in the specification;
- 3) Meridian Project Systems, Inc. does not teach or suggest “a construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer” or a construction system with the functionalities disclosed in the specification;
- 4) Since Meridian Project Systems, Inc. fails to teach or suggest the planning system, construction system, or design system above, Meridian Project Systems cannot render claims 7 and 13 obvious.

In response to argument 1) of the Applicant that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., various aspects associated with the planning system) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Independent claim 1 recites “a planning system to track budgetary information that manages multi-year budgets” and independent claim 14 recites “tracking budgetary information using a planning system”. Therefore, the features

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of the planning system argued by the Applicant, that of tracking of funding sources, allocating of funding sources and scheduling information, maintaining data relating to preliminary site feasibility studies, and other aspects of the planning system disclosed in the specification, are not recited in the claimed invention. Furthermore, claim 14 contains no recitation of handling multi-year projects.

Meridian Project Systems, Inc. teaches a planning system that tracks budgetary information, the budgetary information in claim 1 managing multi-year budgets, in at least page 1, sections 1-2, page 2, section 1, page 3, section 3, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3, wherein planning system features are disclosed that track the budget information. See also pages 30 and 31, page 32, section 1, and page 33, section 1, wherein dates for the project can be entered and multi-year projects planned.

In response to argument 2) of the Applicant that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., various aspects associated with the design system) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Independent claim 1 recites "a design system to perform site engineering assessment" and independent claim 14 recites "performing site engineering assessment using a design system". Therefore, the design functionality and the design system of the specification argued by the Applicant are not recited in the claimed invention.

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Meridian Project Systems, Inc. teaches a design system that performs site engineering assessment in at least page 1, sections 1-4, page 2, section 1, page 3, sections 1-5, page 13, sections 1 and 3, page 15, and page 28, sections 1-3. These pages disclose a system usable by engineers and others to perform assessments at the site and input this information into the system for analysis, reporting, etc.

In response to argument 3) of the Applicant that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., various aspects associated with the construction system) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Independent claim 1 recites "a construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer" and independent claim 14 recites "tracking material consumption and progress for each project using a construction system, the construction system adapted to receive data collected from the handheld computer". Therefore, the aspects of the construction system disclosed in they specification argued by the Applicant in the Appeal Brief are not recited in the claimed invention.

Meridian Project Systems, Inc. teaches a construction system to track material consumption and progress for projects using information received from a handheld computer in page 1, sections 1-2, page 2, section 1, page 3, sections 1-5, page 4, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3.

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In response to argument 4), as explained above in the responses to arguments 1-3, Meridian Project Systems, Inc. does teach and suggest the claimed planning system, the claimed construction system, and the claimed design system. Therefore, claims 7 and 13 can be rendered obvious in light of the teachings of the prior art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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September 29, 2004

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